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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/617,395

07/11/2003

Kazuo Kuroda

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09/26/2005

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

TRAN, THANG V

ART UNIT

PAPER NUMBER

2653

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/617,395

Applicant(s)

KURODA ET AL.

Examiner

Thang V. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-40 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 5-40 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 08/816,138.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Reissue Applications

1. Claims 5-40 are rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. Limitations, which include: prerecorded data, information stored in a memory or performed by storing step; prerecorded data detecting circuit or step; clock signal generating circuit or step, are broader in scope than the original patent claims. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 5-40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. RE38,595. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-7 of the U.S. Patent No. RE38,595 include all limitations as recited claims 5-40 of the present application.

| Claims in the present application | Claims in the U.S. Patent No. RE38,595 |
|-----------------------------------|--|
| 5-7, 12-17, 23-25, 31, 33-35 | 1 |
| 8, 18, 26, 36 | 2 |
| 9, 19, 27, 37 | 3 |
| 10, 20, 28, 38 | 4 |
| 11, 21, 29, 30, 32, 39 | 1, 5 |
| 22, 40 | 6, 7 |

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 5-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Murakami (US 4, 761,775) cited by Applicant.

Regarding claim 5, see Figs. 2-5 of Murakami which show an information data recording apparatus (see Fig. 4) for recording information data on a recording medium (1) having a recording track on which information data is recorded and prerecorded data (12) which are preformed on a portion different from the information recording track at periodic interval (see Fig. 1-3), the apparatus (see Fig. 14) comprising: a memory (142) for temporarily storing the information data to be recorded on the recording medium (11) and supplying the information in synchronism with a clock signal (see column 5, lines 14-18); a prerecorded data signal

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reproducing circuit (129) for detecting the prerecorded data (12) and generating a prerecorded data signal (a clock pit signal c); a clock signal generating circuit (130) for generating the clock signal based on the prerecorded data signal; and a recording device (140, 121, 112) for recording the information data supplied from the memory(142) on the recording track of the recording medium (see column 3, line 17 to column 5, line 25).

Regarding claim 6, see OSC (36) as a reference signal generator that generates a reference signal (clock signal) and the memory (142) stores data in synchronism with the references signal (clock signal) as recited in claim.

Regarding claims 7 and 8, for limitations in these claims, see circuit 131 including PLL circuit 130 comprising: a voltage controlled oscillator (136); a phase comparator (134); and an equalizing circuit (135) as recited in these claims.

Regarding claim 11, see clock signal outputted from OSC 36 for limitation recited in this claim.

Regarding claim 12, see Figs. 2 and 3 for the periodic interval (P) of the prerecorded data (clock pit 12) as recited in this claim.

Regarding claim 13, see Fig. 2 for other prerecording data (address prepits 16) preformed at a second interval smaller than the first interval.

Regarding claim 14, see Figs 2 and 3 for limitations of the unit period and unit length or bi interval as recited in this claim.

Regarding claim 15, see the rejection applied to claim 5 above.

Regarding claim 16, see the rejection applied to claim 6 above.

Regarding claims 17 and 18, see the rejection applied to claims 7 and 8 above.

Regarding claim 21, see the rejection applied to claim 11 above.

Regarding claim 22, see the rejection applied to claim 14 above.

Regarding claim 23, see the rejection applied to claim 5 above.

Regarding claim 24, see the rejection applied to claim 6 above.

Regarding claims 25 and 26, see the rejection applied to claims 7 and 8 above.

Regarding claim 29, see the rejection applied to claim 11 above.

Regarding claim 30, see the rejection applied to claim 12 above.

Regarding claim 31, see the rejection applied to claim 13 above.

Regarding claim 32, see the rejection applied to claim 14 above.

Regarding claim 33, see the rejection applied to claim 5 above.

Regarding claim 34, see the rejection applied to claim 6 above.

Regarding claims 35 and 36, see the rejection applied to claims 7 and 8 above.

Regarding claim 39, see the rejection applied to claim 11 above.

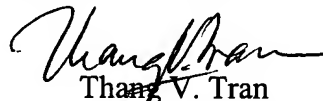
Regarding claim 40, see the rejection applied to claim 14 above.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thang V. Tran whose telephone number is (571) 272-7595. The examiner can normally be reached on M-F 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Thanh V. Tran
Primary Examiner
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